

**REMARKS**

Reconsideration is requested.

Claims 1-10 and 12-29 are pending. Claim 11 has been canceled, without prejudice.

Claims 18-21 and 24-25 have been amended above to obviate the Rule 75(c) objection of the same. Withdrawal of the objection is requested.

Claim 12 has been amended to obviate the Section 112, second paragraph, rejection of the same and withdrawal of the rejection is requested.

The following list of art has been cited in the rejections of the claims contained in the Office Action of August 3, 2005, and the documents will be referred to herein by the document numbers, or "D" numbers, shown:

D1 – U.S. Patent No. 6,773,102 (Chen);

D2 – U.S. Patent No. 5,496,874 (Fass);

D3 – U.S. Patent No. 5,630,868 (Belmont);

D4 – U.S. Patent No. 4,625,220 (Nagashima);

D5 – U.S. Patent No. 4,723,129 (Endo);

D6 – U.S. Patent No. 6,715,869 (Reem);

D7 – U.S. Patent No. 5,169,881 (Peters);

D8 – U.S. Patent No. 5,129,947 (Sharma);

D9 – U.S. Patent No. 4,990,593 (Blount);

D10 – U.S. Patent No. 6,046,253 (Erdtman);

D11 – U.S. Patent Application Publication No. 2003/0187098 (Chen);

D12 – U.S. Patent No. 6,344,497 (Meyrick);

D13 – U.S. Patent No. 5,716,436 (Sorriero);

D14 – U.S. Patent No. 5,464,883 (Sharma);

D15 – U.S. Patent No. 5,922,118 (Johnson); and

D16 – U.S. Patent No. 6,454,402 (Koitarbashi).

The following art rejections are understood to be asserted in the Office Action of August 3, 2005:

(1) Claims 1-10, 12-17 and 22-23 have been rejected as allegedly being anticipated by D1, as evidenced by D2 and D3 (see paragraph number 5 of the Office Action dated August 3, 2005);

(2) Claims 26-29 have been rejected as allegedly being anticipated by D1, as evidenced by D4 and D5 (see paragraph 6 of the Office Action dated August 3, 2005);

(3) Claims 1-6, 9-10 and 12-25 have been rejected as allegedly being anticipated by D6, as evidenced by D2 and D7 (see paragraph number 7 of the Office Action dated August 3, 2005);

(4) Claims 1, 4, 6, 9-10, 12, 16 and 22 have been rejected as allegedly being anticipated by D8 (see paragraph number 8 of the Office Action dated August 3, 2005);

(5) Claims 1-4, , 12 and 15 have been rejected as allegedly being anticipated by D9 (see paragraph number 9 of the Office Action dated August 3, 2005);

(6) Claims 1, 3-4, 6, 9-10 and 12-25 have been rejected as allegedly being anticipated by D10 (see paragraph number 10 of the Office Action dated August 3, 2005);

(7) Claims 26-29 have been rejected as allegedly being anticipated by D10, as evidenced by D4 and D5 (see paragraph number 11 of the Office Action dated August 3, 2005);

(8) Claims 1-6, 9-10, 12-17 and 22-23 have been rejected as allegedly being anticipated by D11, as evidenced by D2 and D7 (see paragraph number 12 of the Office Action dated August 3, 2005);

(9) Claims 13, 26 and 28 have been rejected as allegedly being anticipated by D11, as evidenced by D4 (see paragraph number 13 of the Office Action dated August 3, 2005);

(10) Claim 2 has been rejected as allegedly having been obvious in view of D10 and D12 (see paragraph number 16 of the Office Action dated August 3, 2005);

(11) Claims 2-3 have been rejected as allegedly having been obvious in view of D8 and D13 (see paragraph number 17 of the Office Action dated August 3, 2005);

(12) Claim 5 has been rejected as allegedly having been obvious over D8, D9 and D14 (see paragraph number 18 of the Office Action dated August 3, 2005);

(13) Claim 5 has been rejected as allegedly having been obvious over D8, D10 and D14 (see paragraph number 18 of the Office Action dated August 3, 2005);

(14) Claims 7 and 8 have been rejected as allegedly having been obvious over D6 and D15 (see paragraph number 19 of the Office Action dated August 3, 2005);

(15) Claims 7 and 8 have been rejected as allegedly having been obvious over D8 and D15 (see paragraph number 19 of the Office Action dated August 3, 2005);

(16) Claims 7 and 8 have been rejected as allegedly having been obvious over D9 and D15 (see paragraph number 19 of the Office Action dated August 3, 2005);

(17) Claims 7 and 8 have been rejected as allegedly having been obvious over D10 and D15 (see paragraph number 19 of the Office Action dated August 3, 2005);

(18) Claims 7 and 8 have been rejected as allegedly having been obvious over D11 and D15 (see paragraph number 19 of the Office Action dated August 3, 2005);

(19) Claim 11 has been rejected as allegedly having been obvious in view of D1 and D16 (see paragraph 20 of the Office Action dated August 3, 2005);

(20) Claim 11 has been rejected as allegedly having been obvious in view of D6 and D16 (see paragraph 20 of the Office Action dated August 3, 2005);

(21) Claim 11 has been rejected as allegedly having been obvious in view of D8 and D16 (see paragraph 20 of the Office Action dated August 3, 2005);

(22) Claim 11 has been rejected as allegedly having been obvious in view of D9 and D16 (see paragraph 20 of the Office Action dated August 3, 2005);

(23) Claim 11 has been rejected as allegedly having been obvious in view of D10 and D16 (see paragraph 20 of the Office Action dated August 3, 2005);

(24) Claim 11 has been rejected as allegedly having been obvious in view of D11 and D16 (see paragraph 20 of the Office Action dated August 3, 2005); and

(25) Claims 27 and 29 have been rejected as allegedly having been obvious in view of D6, D8 and D5 (see paragraph 21 of the Office Action dated August 3, 2005).

The Examiner is requested to advise the undersigned in the event the above restatement of the outstanding rejections is in error.

The above rejections are traversed. Reconsideration and withdrawal of the rejections are requested in view of the following distinguishing comments.

**Rejections (1)–(18) and (25)**

The recitation of claim 11, which was not rejected in any of rejections (1)–(18) and (25), has been added to claim 1, to advance prosecution, without prejudice. Claim 11 has been canceled, without prejudice. The claims are submitted to be patentable over the individual art or combinations of art applied in rejections (1)–(18) and (25). Withdrawal of rejections (1)–(18) and (25), above, is requested.

**Rejections (19)–(24)**

As noted above, the claims now require the nonionic surfactant at a concentration recited in originally-filed claim 11. Claim 11 has been rejected in each of rejections (19) – (24). In each of rejections (19)–(24), the Examiner is understood to have combined a previously-cited primary reference (i.e., separately, D1, D6, D8, D9, D10 and D11, which were the basis of the anticipation rejections (1)–(9)) with document D16 which allegedly discloses use of a nonionic surfactant (i.e., Acetylenol™, which is understood by the undersigned to be an ethylene oxide adduct of 2,4,7,9–tetramethyl-5-decyne-4,7-diol manufactured by Kawaken Fine Chemicals Co., Ltd.) in an ink jet ink.

The Examiner's statement on page 15, 4<sup>th</sup> full paragraph, of the Office Action that each of D1, D6, D8, D9, D10 and D11 "disclose nonionic surfactant" is not understood and clarification is requested, along with a citation of where the references include such a disclosure, in the event any of rejections (19)–(24) are maintained. D1, D6, D8, D9, D10 and D11 are not believed to disclose or suggest an ink composition containing a nonionic surfactant in the recited amount.

Further, there was no motivation in the cited art to have combined a nonionic surfactant with a polyester containing ink composition, such as the presently claimed ink composition. More specifically, D16 does not disclose or suggest ink compositions containing a polyester resin containing a polybasic carboxylic acid ingredient and a polyhydric alcohol ingredient, as required by the present claims. Further, D16 does not disclose or suggest ink compositions containing a polyester resin containing a polybasic carboxylic acid ingredient and a polyhydric alcohol ingredient wherein the polybasic carboxylic acid ingredient contains an aromatic dicarboxylic acid having a metal sulfonate group, as required by the present claims.

In fact, the use of a nonionic surfactant in the teaching of D16 is contrary to the presently claimed invention which includes a nonionic surfactant in the ink composition. Specifically, D16 teaches the use of a surfactant (i.e., Acetylenol<sup>TM</sup>) as a penetrating agent which is separately applied to a surface to be printed. The surfactant of D16 is not a component of the ink composition to be applied to the surface. See claims 3 and 9 of D16 for example. Combination of D16 with any of the cited primary references would not have made the presently claimed invention obvious.

The applicants submit that one of ordinary skill would not have been motivated by the cited art to combine a nonionic surfactant at a critical micelle concentration and a polyester resin containing a polybasic carboxylic acid ingredient which contains an aromatic dicarboxylic acid having a metal sulfonate group, as claimed.

The claims are submitted to be patentable over the combination of art cited in rejections (19)–(24) and withdrawal of the rejections are requested.

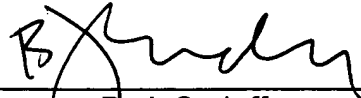
KAMOTO, T. et al.  
Appl. No. 10/664,895  
November 2, 2005

The claims are submitted to be in condition for allowance and a Notice to that effect is requested. The Examiner is requested to advise the undersigned in the event anything further is required.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_



B. J. Sadoff  
Reg. No. 36,663

BJS:  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100